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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,184	09/21/2000	Kyoko Matsumoto	TAK-140-USAP	9127

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Ronald R Snider
PO Box 27613
Washington, DC 20038-7613

EXAMINER

BLECK, CAROLYN M

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/666,184

Applicant(s)

MATSUMOTO ET AL.

Examiner

Carolyn M Bleck

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 19 April 2003. Claims 1-8 are pending. Claims 1-5 have been amended. Claims 6-8 are newly added.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. The rejections of claims 1-5 under 35 U.S.C. 112, second paragraph, are hereby withdrawn due to the amendment filed 19 April 2003.
4. Claims 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) As per claims 7 and 8, line 2, "the plurality of important points" lacks antecedent basis. For purposes of applying prior art, "the plurality of important points" is assumed to be a coordinate.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Utsugi (6,502,583).

(A) As per claim 1, Utsugi discloses a makeup method for applying makeup (col. 10 lines 59-60) comprising:

(a) determining an average face for each race from a plurality of faces through image processing wherein the eye brows, eyes, a nose, and a mouth are used to determine the average or ideal face (col. 1 line 13 to col. 2 line 50, col. 7 lines 1-55, col. 8 lines 8-22, col. 10 lines 1-41);

(b) asking a subject person specific questions to determine the impression of an average or ideal face, wherein the asking is performed on multiple people (col. 1 line 52 to col. 2 line 14, col. 8 lines 8-24);

(c) based on the questions, determining a desirable face and performing image processing on an image of a face thereby forming images of imagined post-makeup faces, wherein a segment of the image of the post makeup face undergoes image processing to determine a plurality of bright areas and dark areas (reads on "image map" and "color map") (col. 4 lines 41-55, col. 5 lines 5-40, col. 8 lines 8-24, col. 8 line 65 to col. 9 line 38); and

(d) acquiring color data for the segmented areas (reads on "color map"), wherein based upon the obtained color data of each area, a foundation to be applied on that area is determined (Fig. 4, col. line 65 to col. 9 line 38, col. 10 lines 1-42).

As per the recitation of a "color map", it is respectfully submitted that the segmentation of the data discussed above is considered to be used as data "for a color map", and the skilled artisan would have found this an obvious modification to the method of Utsugi with the motivation of properly analyzing color data to determine the proper foundation or makeup for a person (Utsugi; col. 4 lines 41-55).

(B) As per claim 2, Utsugi discloses obtaining information based on each race (col. 8 lines 8-22). The remainder of claim 2 repeats the same limitations as claim 1, and is therefore rejected for the same reasons, and incorporated herein (note the discussion of "color maps").

(C) As per claim 3, Utsugi discloses the color data including eye color (col. 3 lines 1-64) and displaying faces which are ideal (reads on "obtaining maps where desirable images are clarified for selection") (Fig. 3a-4, col. 3 line 1 to col. 4 line 55). The remainder of claim 2 repeats the same limitations as claim 1, and is therefore rejected for the same reasons, and incorporated herein (note the discussion of "color maps").

(D) As per claim 4, Utsugi includes the color data consisting of hue and brightness (reads on "tone"), and is displayed in a chart with a horizontal and vertical axes (Fig. 1,

col. 2 lines 30-35, col. 4 lines 41-55, and col. 7 lines 3-60). The remainder of claim 4 repeats the same limitations as claim 1, and is therefore rejected for the same reasons, and incorporated herein (note the discussion of "color maps").

(E) As per claim 5, Utsugi fails to expressly disclose color maps comprise charts having a horizontal axis expressing an image of "Active- Gentle" and a longitudinal axis expressing an image of "Fresh-Elegant." However, as disclosed above in the rejection of claim 4, Utsugi discloses the color data consisting of hue and brightness (reads on "tone"), and is displayed in a chart with a horizontal and vertical access (Fig. 1, col. 2 lines 30-35, col. 4 lines 41-55, and col. 7 lines 3-60).

It is respectfully submitted that using charts to display changes or variations in color is a technique typically used, and the skilled artisan would have found it an obvious modification within the method of Utsugi with the motivation of providing to consumers the effects of different color cosmetics on their faces and obtaining color data of each area to determine foundation to apply to those areas (Utsugi; col. 9 lines 8-11).

(F) As per claim 6, Utsugi discloses using a morphing program (col. 7 lines 1-55).

(G) As per claims 7 and 8, Utsugi discloses the coordinate values of facial constituents including eyebrows, eyes, a nose, and a mouth (col. 7 lines 15-27).

Response to Arguments

7. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's arguments filed 19 April 2003 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 19 April 2003.

(A) At page 6 of the 19 April 2003 response, Applicant argues that features, including the newly added features in the 19 April 2003 amendment, are not taught or suggested by the applied references.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 19 April 2003 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the teachings of Utsugi based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and

(iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specifically support that particular motivation. It is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. And Inter., 4/22/93).

As such, is respectfully submitted that Applicant appears to view the applied references, separately and in a vacuum, without considering the knowledge of average skill in the art.

(B) At pages 6-7 of the 19 April 2003 response, Applicant argues that certain features are not taught or suggested by the applied references.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a colorimetry study", "collects color data based upon the plurality of enquiries among different races of people to receive opinions of those people", "displays on a monitor an image of a face", "to obtain data in order to understand color information relating to desirable colors") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to the Applicant's disclosure. The cited but not applied prior art teaches a method for classifying features and a map representing the features (6,091,836), a method and apparatus for aligning and comparing images of the face and body from different imagers (6,496,594), and skin imaging and analysis systems and methods (6,571,003).

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

12. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]


(703) 746-8374 [Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor (Receptionist).

CB

CB

June 16, 2003


JOSEPH THOMAS
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